

In re application of: Luciano
Serial Number 09/638,666
Page 2

In the Abstract

Please amend the Abstract as indicated in Appendices E and F submitted herewith. Appendix E is a mark-up copy of the Abstract, and Appendix F is a clean copy of the amended claims.

5

REMARKS

Claims 1-57 and 65-79 were pending in this case. The Examiner objected to typographical errors in Figure 2 and the Specification, noted the need to include essential material other than by incorporation by reference, objected to the term "The specification discloses" in the Abstract, objected to the use of the term "the" rather than "said" in claims 5-8, 10 14, and 41-44, rejected claims 1, 9, 37, 65, 68, and their dependent claims under Section 112, and rejected all claims under Section 103. The applicant has cancelled claims 5-8 and 15-19 and amended the remaining claims 1-5, 9-14, 18-57, and 65-79. In view of the above amendments, the applicants submit that all claims are in condition for allowance.

With regard to Figure 2, the Examiner objected to two typographical errors in the 15 drawing. The enclosed substitute Figure 2 corrects these errors.

With regard to the Specification, the Examiner objected to two typographical errors, one on page 12 and the other on page 18. The applicant has corrected these errors in the accompanying amendments to the involved paragraphs. See Appendices A and B.

With regard to the incorporation by reference of the applicant's provisional application in 20 the Cross Reference to Related Applications (page 2 of the Specification), the applicant does not believe this incorporation refers to any essential material. The applicant therefore has not added to this Specification any material from the provisional application.

In re application of: Luciano
Serial Number 09/638,666
Page 3

With regard to the objection to the Abstract, the applicant has amended the Abstract to delete the terms to which the Examiner objected. See Appendices E and F.

With regard to the Examiner's objection to the use of the term "the" rather than "said" in claims 5-8, 14, and 41-44, the applicant has amended all claims to make this same type of substitution. See Appendices C and D.

With regard to the Examiner's rejection of claims 13-19 under Section 112, the Examiner stated that "one of ordinary skill would not understand the metes and bounds of that which is claimed" in these claims. Office Action at 3. The Office Action did not further explain the basis for this rejection. The applicant has reviewed those of claims 13-19 which remain in this case (claims 13, 14, 18, and 19) and does not understand the nature of the Examiner's concern. The applicant therefore requests reconsideration of this rejection.

The Examiner also rejected claims 1, 9, 37, 65, and 68 for "interchanging" use of the term "activator" and "actuator." Office Action at 3. In one claim set, for example, claims 1 and its dependents, the applicant uses a term "activatable" because this term is supported by the specification. In other separate claim sets, such as claim 9 and its dependents, the applicant uses the term "actuator" because this term is supported by the specification as well. The applicant respectfully submits that it is proper for the applicant to use differing terms in differing claim sets – as opposed to the use of interchanging terms in a single claim or its dependents to refer to the same element or step in the claim set. In this latter event, the use of interchanging terms in the claim set can create antecedent basis issues. Among differing claim sets, however, the applicant submits that use of differing terms does not present an antecedent basis problem, is therefore not really "interchanging," and instead helps seeks to ensure that the applicant is

In re application of: Luciano
Serial Number 09/638,666
Page 4

procuring differing claims of differing breadth. Since these differing terms in the differing claim sets are supported by the specification and present no antecedent basis issues, the applicant respectfully requests reconsideration of this rejection to the extent it is directed to use of differing terms in differing claim sets.

5 The applicant notes that, in Claim set 9, the applicant has referred to a "first game actuator" and a "second game activator." The applicant respectfully submits that this use of differing terms for differing elements is proper, but the applicant has amended claim 9 to use the one term "actuator" throughout the claim. Appendix C at 13.

10 With regard to the Examiner's obviousness rejection of Claim 1-10, 19, 21-22, 24, 26, 28-29, 31, 33-34, 36, 50, 52, 54, and 56 over Mayeroff '483 in view of Stanley, the Examiner explained that Mayeroff '483 provides a first spinning reel game and a second spinning wheel game, and the second spinning wheel game provides a range of outcomes that can alter the award – but not the first spinning reel game outcome – to the game player by providing an additional award.

15 The Examiner relied on Stanley as a teaching of a game in which a second wheel game can provide a range of outcomes that can alter the displayed outcome – as opposed to the award provided by -- the first game. The applicant respectfully submits, however, that the Stanley reference is an extremely cursory disclosure. Particularly with regard to this aspect of the Stanley reference, the applicant submits that Stanley provides no teaching of how to make and
20 use such a feature. Since the Stanley reference provides no such teaching, the asserted combination does not yield the claimed subject matter of the claims in issue. The claims in issue

In re application of: Luciano
Serial Number 09/638,666
Page 5

(1-4, 10, 19, 21-22, 24, 26, 28-29, 31, 33-34, 36, 50, 52, 54, and 56) are therefore allowable over the asserted combination as a matter of law.

In addition, with regard to independent claim 1 and its dependent claims 2-4, neither Stanley nor Mayeroff '483 provide any disclosure, much less a teaching, of any second game in which the second game is activatable "to display on said second game outcome display . . . an alteration of said first game outcome procured or to be procured in a future play of said first game of chance upon the occurrence of at least a first predetermine first game alteration outcome in said second game of chance." Appendix C, Claim 1. Similarly, neither Stanley nor Mayeroff '483 provide any disclosure or teaching of the feature of former claim 5, which applicant has inserted into claim 1: a second game "wherein said range of second game chance outcomes includes a first game playing outcome whereby said first game of chance may be played again, and wherein said second game of chance is connected to said first game of chance so that said second game of chance is again activatable upon the occurrence of said or another predetermined event in said first game of chance." *Id.*

Thus, even if Stanley were considered to be an adequate teaching and could be combined in the fashion proposed by the Office Action, the combination does not yield the claimed subject matter. Claims 1-4 are therefore allowable over the asserted combination of Mayeroff '483 and Stanley as a matter of law.

It should also be noted that claims 2-4 include additional advantageous subject matter rendering these claims even further afield from the asserted combination of Mayeroff '483 and Stanley. These claims are therefore allowable for this additional reason as well.

In re application of: Luciano
Serial Number 09/638,666
Page 6

In this regard, claim 3 adds that the "range of second game chance outcomes includes a chance-improving outcome whereby said game player's chance of procuring at least one future first game outcome and future award is improved." Id., Claim 3. The applicant respectfully submits that neither Mayeroff '483 nor Stanley disclose or teach any such subject matter. Claim 3 is therefore allowable for this reason as well.

With regard to independent claim 9 and its dependent claims 10, 19, 21-22, 24, 26, 28-29, 31, and 33-34 and their rejection over Mayeroff '483 in view of Stanley, these claims also include elements not disclosed, much less taught, by either Mayeroff '483 or Stanley. For example, Claim 9 recites:

- 10 D. a game outcome linkage interconnecting said first and second games of chance to
change said or another game outcome in said first game outcome display upon the
appearance of at least one predetermined changing outcome in said second game
outcome display; and wherein at least one predetermined changing outcome allows
15 said first game of chance apparatus to be played again, and said second game
actuator is adapted to again actuate said second game of chance apparatus upon the
occurrence of said one or another predetermined first game outcome in said first
game of chance apparatus.

Appendix C, claim 9. This subject matter is not disclosed or taught by either Mayeroff '483 or Stanley. The applicant therefore submits that Claim 9 and its dependents presently in issue (10, 19, 21-22, 24, 26, 28-29, 31, 33-34, 36) are allowable over the asserted combination of Mayeroff '483 and Stanley.

The Examiner rejected dependent claims 11-14, 18, 20, 23, 25, 27, 30, 32, and 35 and as obvious over Mayeroff '483 in view of Stanley and further in view of Crawford. Each of these claims depends from claim 9, and as noted above, neither Mayeroff '483 nor Stanley teach multiple aspects of subject matter recited in claim 9.

In re application of: Luciano
Serial Number 09/638,666
Page 7

With regard to the third reference in this asserted combination, Crawford, the Examiner stated that Crawford includes a save symbol feature, rendering obvious the features of, for example, Claim 11 which recites:

5 The gaming apparatus of claim 9 including a game outcome bank connected to said second game of chance apparatus whereby at least one second game outcome may be stored and later transferred by said first game outcome linkage to said first game outcome display in said first game of chance.

Appendix C, claim 11. The Examiner did not rely on Crawford for teaching other features of the
10 type not present in Mayeroff '483 and Stanley as noted above. Office Action at 6. Therefore, since claim 9 is allowable over the combination of Mayeroff '483 and Stanley and Crawford does not teach any such aspects, these dependent claims are also allowable over the asserted combination of Mayeroff '483, Stanley, and Crawford.

In addition, even if these references disclosed the elements of the claims in one fashion or
15 another, the applicant respectfully submits that there is no suggestion or motivation for picking and choosing among features in these three references to yield the claimed subject matter. The Examiner stated that by selecting among these features and assembling them into one device, the user would get more enjoyment out of the bonus round and therefore it would have been obvious to pick and choose among the various features in Mayeroff '483, Stanley, and Crawford. *Id.*
20 The applicant submits, however, that this constitutes hindsight picking and choosing among references based on the result presented to the Examiner in the claims.

Many in the gaming industry do continually try to develop improved products, and in the gaming industry that includes seeking to provide products that provide more gaming enjoyment in an economical and profitable fashion. This objective does not provide the requisite suggestion

In re application of: Luciano
Serial Number 09/638,666
Page 8

or motivation for picking and choosing among various prior art references to yield the claimed subject matter. On the contrary, this common goal, along with the lack of the combination in any single reference in the prior art, show the opposite – that there is no suggestion or motivation to combine as asserted by the Examiner and that the claimed combination was not obvious in fact to those skilled in the art notwithstanding this common goal in the industry.

Dependent claims 11-14, 18, 20, 23, 25, 27, 30, 32, and 35 are therefore allowable over the asserted combination of Mayeroff '483, Stanley, and Crawford for a variety of reasons. In this regard, the applicant notes that claim 18 does not include the game outcome saving feature of, for example, claim 11. The applicants therefore suspect that the Office Action's reference to claim "18" in this rejection may be a typographical error and should instead be a reference to claim "19" (which does include the game outcome saving feature). In this event, it is claim 19 rather than 18 that is allowable over the asserted combination of Mayeroff '483, Stanley, and Crawford as noted above.

The Examiner rejected independent claim 37 and its dependent claims 38-40, 45, and 46 over Mayeroff '483 in view of Stanley and further in view of Kaku. The Examiner relied on Mayeroff '483 and Stanley to the same extent previously asserted in the Office Action, to which the applicant has responded above. In this regard, as noted above (at 4, ll. 16-22), Stanley does not really provide a teaching of how to make and use a multi-game apparatus as claimed in Claim 37, which includes: "D. a first game outcome linkage being adapted to change said outcome in said first game upon the occurrence of at least one among a plurality of possible first wheel outcomes or second wheel outcomes in the said concentric wheel game apparatus." For

In re application of: Luciano
Serial Number 09/638,666
Page 9

this reason alone, Claim 37 (and its dependents) are allowable over Mayeroff '483 in view of Stanley and Kaku.

In addition, independent Claim 37 and its dependents in issue (38-40, 45, and 46) recite a multi-game apparatus having, among other things, "B. a concentric wheel game apparatus, said
5 concentric wheel game apparatus including an outer wheel rotatable to yield a first game outcome and an inner wheel rotatable to yield a second wheel outcome . . ." (Appendix C, claim 37) Other claim elements recite additional features having a relationship as stated to the concentric wheel game apparatus. *Id.* The Examiner cited the Kaku reference as a concentric wheel apparatus, and thus the Examiner stated that it would have been obvious to incorporate the
10 concentric wheel structure of Kaku with the asserted combination of Mayeroff '483 and Stanley. The applicants respectfully submit that, in addition to the lack of teaching of Mayeroff '483 and Stanley as noted above, there is no suggestion or motivation for picking and choosing disparate pieces among these three references to yield a structure as recited in the claims. That the structure of Kaku may provide more excitement does not itself provide a motivation for
15 incorporation of a portion of Kaku into the asserted selections from Mayeroff '483 and Stanley. On the contrary, the wheel structure of Kaku is relatively complex and costly to manufacture, so the teaching of Kaku would not provide motivation for inclusion of such a complex and costly structure in the claimed apparatus.

Independent claim 37 and its dependent claims 38-40, 45, and 46 are therefore allowable
20 over Mayeroff '483, Stanley, and Kaku for a variety of reasons.

With regard to the remaining claims that depend from 37 (41-44 and 47-49), the Examiner rejected these claims as obvious over (i) Mayeroff '483 in view of (ii) Stanley, and

In re application of: Luciano
Serial Number 09/638,666
Page 10

further in view of (iii) Kaku, and further in view of (iv) Crawford. The applicant submits that the asserted combination of four distinct references constitutes impermissible hindsight picking and choosing, and for this reason alone, these claims are allowable.

Dependent claim 41-44 recites, for example, that the multi-game apparatus' "first wheel
5 outcome or second wheel outcome include a bank item useable to alter said or a later first game outcome." As noted above, the Examiner cited Crawford for this bank feature, but again, the applicant submits that this constitutes hindsight picking and choosing select portions from among four patent references in order to purportedly yield the claimed invention. Again, the applicant respectfully submits there is no motivation or suggestion for any such picking and choosing
10 among such a large number of references. Although the Office Action states that one would do so to increase excitement, the applicant submits that this general goal itself shows that the applicant's development of the claimed subject matter years after publication of these references itself shows the unobviousness of the applicant's claimed invention.

Also, as noted above with regard to the underlying combination of Mayeroff '483,
15 Stanley, and Kaku, that asserted combination is also improper as explained above (at 8-9), and Stanley does not provide the requisite teaching. For these reasons as well, the dependent claims in issue (41-44 and 47-49) are allowable over the asserted combination of four references: Mayeroff '483, Stanley, Kaku, and Crawford.

As noted above, the Examiner rejected independent claim 50 and its dependent claims 52,
20 54, and 56 as obvious over Mayeroff '483 and Stanley. The applicant explained above (at 4-5) how these claims are all allowable over that asserted combination. In addition, claim 50 recites:
"E. a second game of chance outcome display connected to said first game of chance controller

In re application of: Luciano
Serial Number 09/638,666
Page 11

and including second game outcome indicia indicating a second game award opportunity for the player to replay the first game of chance” (Appendix C, claim 50.) Since neither Mayeroff ‘483 or Stanley teach any such structure, claim 50, and all of its dependent claims in issue (52, 54, and 56), are allowable over this asserted combination for this reason as well.

5 These claims depending from claim 50 also recite additional features rendering them even further afield from the asserted combination of Mayeroff ‘483 and Stanley. For example, claim 56 recites that the recited structures are “mounted in an integral game frame.” (*Id.*, claim 56.) This additional advantageous feature renders this claim all the more allowable over the prior art.

10 With regard to method claims 65-79, the Examiner rejected them for being an “end-use” of the disclosed apparatus. The Examiner explained that “It is well understood by those of skill in the art that the ‘end-use’ of a well-known product is not patentable where there has not been a showing of criticality for that ‘end-use’ being claimed as a method.” Office Action at 9. Although this postulate may be true in certain contexts, the applicant submits that this postulate
15 does not apply here as there is no “well-known product” here. Indeed, the Office Action includes no anticipation rejection and instead asserts combinations of portions of prior art apparatus render the claimed subject matter obvious. There is, therefore, no well known product here, and thus the postulate about claiming only an “end-use” of a well known product does not apply.

20 In addition, the applicant disagrees that the claimed end-use step is shown in the prior art. For example, independent claim 65 recites:

In re application of: Luciano
Serial Number 09/638,666
Page 12

- B. actuating said bonus game of chance to procure a bonus game outcome and, upon the appearance of a predetermined bonus game outcome in said bonus game of chance, a second bonus opportunity to again play said base game of chance; and
C. in the event of said second bonus opportunity, again actuating said base game of chance to procure a second base game of chance.

(Appendix C, claim 65.) The applicant respectfully submits that there is no teaching of any such method, or machine necessarily providing such a method, in the cited prior art. Claim 65 and its dependents are therefore allowable for this reason too.

As another particularized example, independent claim 68 recites a base game of chance and the bonus game of chance through which a player may procure a "bonus award including a bank portion transferred to a game bank, for alteration of said or another base game outcome in said base game of chance." (Appendix C, claim 68.) The applicant respectfully submits that there is no such method disclosed in the prior art, nor is this step an "end use" of any apparatus in the cited prior art. Claim 68 and its dependents are therefore allowable for this reason as well.

The claims depending from 65 and 68, respectively, recite additional advantageous features rendering their respective claimed subject matter even further afield from the asserted prior art. They are therefore allowable for reasons in addition to those noted above for claim 65.

The applicant recognizes that the Examiner stated that the applicant must show that the claimed method steps are critical in order to overcome the obviousness rejection of the method claims 65-79. The applicant respectfully disagrees, however. The burden is on the Patent Office to show all claimed features in the prior art and establish why it would have been obvious to one skilled in the art at the time of invention to combine them in the fashion claimed. In doing so, the Patent Office must show a suggestion or motivation to make the claimed combination in the record. Thus, the applicant respectfully submits that "criticality" of a claim feature is not the

In re application of: Luciano
Serial Number 09/638,666
Page 13

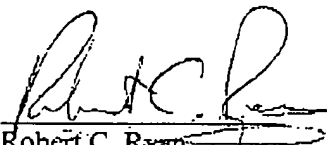
issue; nor is it the applicant's burden to show criticality of a claim feature, particularly where, as here, that claim feature is not shown anywhere in the prior art. One issue is whether the Patent Office can show, among other things, each and every claim element in the prior art and show in the record an adequate motivation or suggestion, to one skilled in the art at the time of invention, to combine these teachings to yield the claimed subject matter. Since the Office Action cited no teachings of claimed elements and features, the purported combination cannot yield the claimed elements or features, or render them obvious, as a matter of law.

Finally, the applicant respectfully submits that the obviousness rejections are insufficient under the four-pronged Graham v. Deere inquiry acknowledged in the Office Action. Although the Office Action acknowledges this four-pronged inquiry, it did not articulate the required findings for the four inquiries or cite or explain evidence supporting any such findings. The applicant therefore respectfully submits that, for this reason too, all claims are allowable

In conclusion, the applicant submits that the present application and all pending claims are in condition for allowance. If the Examiner has any questions regarding the application or this response, the Examiner is encouraged to call the applicant's attorney, Robert C. Ryan, at (775) 686-5050.

Respectfully submitted,

Dated: January 3, 2003


Robert C. Ryan
Attorney for Applicant
Registration Number: 29,343

In re application of: Luciano
Serial Number 09/638,666
Page 14

APPENDIX A

(Mark-up Copy of Amendments to Specification)

Please amend the first paragraph of page 12 as follows:

5

Referring now to Figure 1, the preferred embodiment, generally 10, has a two wagering games-of-chance 12; 14. The first game-of-chance 12 is a spinning reel game, and the second game-of-chance 1[2]4 is a spinning wheel game. The spinning reel game 12 and spinning wheel game 14 are mounted in the same game box 16, with the spinning wheel game mounted in the
10 game box 16 vertically above the spinning reel game 12. A spinning reel outcome bank 18 is mounted between the spinning reel game 12 and the spinning wheel game 14.

Please amend section 5 on page 18 – 19 with the following:

- 15 5. If one of the reels 22, 24, 26 in the stop position 110 displays a “spin wheels” symbol 114, the wheel game 14 is activated 116 and the three concentric wheels 42, 44, 46 spin and stop at a stopping position 116 in sequence, with the outer wheel 42 stopping first, the middle wheel 44 stopping second, and the inner wheel 46 stopping last. The resulting
20 stopping position 116 is also randomly generated by a random number generator incorporated into the wheel game 14 in a fashion well known to those skilled in the art. In an alternative embodiment, wheels 42, 44, and 46 are not spun to randomly determined stopping positions. Rather, the position of the wheels 42, 44, and 46 are adjusted based

In re application of: Luciano
Serial Number 09/638,666
Page 15

on incremental adjusting commands displayed on reels 22, 24, and 26. For example, reel 22 may display a symbol that requires wheel 42 to be rotated in one position, in which case wheel 42 is advanced one position. The wheel adjusting commands may require any or all of wheels 42, 44, and 46 to be moved any number of positions in either direction.

5 Because the stopping positions of wheels 42, 44, and 46 are dependent on the starting position of the wheels and the outcome of reels 22, 24, and 26, game 14 can be viewed as an extension of game 12 rather than an independent bonus game. In this embodiment, wheels 42, 44, and 46 may be moved to randomly determined starting positions when

10 game apparatus 10 is first turned on.